

REMARKS

This Response is submitted in reply to the Office Action dated November 13, 2009, and in conjunction with the enclosed Request for Continued Examination. Claims 1, 28, 40, 48, 56, 74, 85 and 86 have been amended for clarity. No new matter has been added by such amendments. Please charge deposit account 02-1818 for any fees which are due in connection with this Response and Request for Continued Examination.

As noted above, Applicant has filed a Request for Continued Examination with this Response. Accordingly, Applicant requests that the Examiner allow this application or in the next Office Action identify "any claims which he or she judges, as presently recited, to be allowable and/or . . . suggest any way in which he or she considers that rejected claims may be amended to make them allowable" in accordance with §707.07(d) of the MPEP.

The Office Action rejected claims 1 to 93 under 35 U.S.C. §103(a) as being unpatentable over Walker et al. (U.S. Patent No. 6,203,430; hereafter "Walker '430") in view of Graham et al. (U.S. Patent No. 6,491,584; hereafter "Graham") and further in view of Walker et al. (U.S. Patent No. 6,319,127; hereafter "Walker '127"). Applicant respectfully disagrees and traverses this rejection. Additionally, Applicant has amended independent Claims 1, 28, 40, 48, 56, 74, and 85 for clarity.

Amended independent Claim 1 is directed to a gaming device that comprises at least one display device; at least one input device; at least one processor; and at least one memory device which stores a plurality of instructions, which when executed by the at least one processor, cause the at least one processor to operate with the at least one display device and the at least one input device to: (i) display a plurality of reels, the plurality of reels including a plurality of symbols, the symbols including at least one prize symbol associated with a physical prize and at least one re-trigger symbol, (ii) display a first designated number, the first designated number being equal to a quantity of initial spins of the reels which will subsequently be displayed, the quantity of initial spins being greater than one, (iii) after a wager by a player: (a) display one of the initial spins of the reels, (b) cause the displayed first designated number to indicate the quantity of initial

spins remaining to be subsequently displayed, and (c) repeat (a) and (b) until none of the quantity of initial spins remain, (iv) display at least one additional spin of the reels if a predetermined symbol combination including the re-trigger symbol occurs on the reels during the displayed initial spins of the reels, (v) accumulate any prize symbols which occur on the reels in each of the displayed initial spins and the at least one additional spin of the reels, and (vi) cause the physical prize to be awarded to the player if the accumulated number of prize symbols reaches a second designated number of prize symbols necessary to be accumulated to win the associated physical prize, wherein the second designated number of prize symbols is greater than the number of prize symbols which can possibly be accumulated in the displayed initial spins of the reels.

Walker '430 discloses a slot machine that identifies a tracked symbol and initializes a running count representing active occurrences of the tracked symbol generated during a play session. During the play session, the slot machine increases the running count to reflect occurrences of the tracked symbol and decreases the running count to reflect expiration of occurrences of the tracked symbol. If the running count reaches a predetermined level, the slot machine determines a bonus payout based on the running count (abstract).

Graham discloses a gaming machine, wherein if "[a] triggering condition results in an initial series of free games, and during the initial series of free games, another trigger condition arises, a subsequent series of free games, including a bonus feature, is awarded" (abstract). More specifically, Graham discloses that "[w]hen a base game is played on the machine 10 and a trigger condition arises an initial series of free games is provided" (col. 3, lines 7 to 10).

Walker '127 discloses a gaming device which provides a flat rate play session that costs a flat rate price. The flat rate play session spans multiple plays on the gaming device over a pre-established duration. The gaming device identifies price parameters and determines the flat rate price of playing the gaming device based on those price parameters (abstract).

To establish a *prima facie* case of obviousness under 35 U.S.C. § 103, the Examiner must explain the reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select

the elements from the cited prior art and combine those elements in the same manner as the claimed invention. These reasons need to be specific reasons, not general overarching reasons for combining multiple prior art references or groups of such references.

In this case, the Examiner does not explain why one of ordinary skill in the art would be motivated or otherwise have a reason to combine Walker '430 and Graham in the manner suggested by the Office Action. The Examiner generally concludes that it would have been obvious to one skilled in the art at the time the invention was made to combine Walker '430 and Graham to "retain and attract potential gaming customers." This is clearly a general reason and not a specific reason. Additionally, the Office Action merely concludes that it would have been obvious to one skilled in the art at the time the invention was made to combine Walker '430, Graham and Walker '127 to "advantageously allow the player to play multiple games while only making funds available at the beginning of his play session." Applicant submits that these general reasons are insufficient reasons or motivations to combine Walker '430, Graham and Walker '127. Such general reasons of combining references result in nearly every reference in the gaming industry being combinable with nearly every other reference in the gaming industry. This is clearly not the case. Accordingly, this rejection is improper and should be withdrawn.

Additionally, Applicant submits that the Examiner ignores the warnings of the Supreme Court in KSR International Company v. Teleflex Inc., et al., (550 U.S. 398, 2007) that a "factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning." The present Office Action is improperly working backwards from the claimed invention to piece together elements from different references to form the claimed invention. Obviousness cannot be based on the hindsight combination of components selectively culled from prior art to fit the parameters of the claimed invention. The Office Action's picking and choosing among individual parts of assorted prior art references as a mosaic to recreate a facsimile of the claimed invention is clearly improper.

In this case, the Office Action stated that Walker '430 and Graham lack "in explicitly teaching wherein the initial designated number of spins is greater than one and

that the numerical quantity of spins is displayed (as recited by the amended claims)." However, the Office Action suggested to modify the combination of Walker '430 and Graham with Walker '127 to "advantageously allow the player to play multiple games while only making funds available at the beginning of his play session."

The Office Action recognized that Walker '430 discloses a gaming session which begins at a slot machine (e.g., when a player inserts a player tracking card or currency) and that the player plays a number of games during the gaming session. See Walker '430, col. 4, lines 40-44 and col. 8, lines 35-40. Specifically, Walker '430 discloses that "the slot machine identifies at least one tracked symbol, and throughout the [gaming] session, the slot machine maintains a running count of the number of times the tracked symbol occurs in a generated outcome." See Walker '430, col. 4, lines 45-48.

Page 3 of the Office Action equates the number of games in a player's gaming session of Walker '430 to a "designated number of initial spins". Specifically, the Office Action states:

[d]isplay a designated number of initial spins of the reels (see at least 3:33-51). In Walker '430, the player may designate the number of spins by controlling the wager of a number of credits and actuating the starting controller 350 (see at least 6:9-20 and 8:34-49).

Additionally, page 5 of the Office Action states:

[t]he combination of Walker '430 and Graham teaches the invention substantially as described above, but lacks in explicitly teaching wherein the initial designated number of spins is greater than one and that the numerical quantity of spins is displayed (as recited by the amended claims). Walker '127 teaches a flat rate play session, which is "defined as a period of play wherein the player need not make funds available for any play during the play session" and the "flat rate play session spans multiple plays of the gaming device" wherein the interval of play may be "handle pulls" (see 3:22-31).

Applicant submits that, Walker '430 does not appear to display a designated number equal to a quantity of initial spins of the reels which will be subsequently displayed because the gaming session of Walker '430 is player dependent. In Walker '430, the player determines when to start and stop the gaming session. Depending on

when the player starts and stops that player's gaming session, the gaming session could include a plurality of games. In Walker '430, for a gaming session to have a plurality of games (and spins), the player is required to place a plurality of wagers (i.e., the player is required to place one wager for each spin of the reels). Thus, the quantity or number of games in the gaming session of Walker '430 is determined by the player (not the gaming device of Walker '430). Accordingly, Walker '430 does not appear to display a first designated number, wherein the first designated number is equal to a quantity of initial spins of the reels which will be subsequently displayed.

Additionally, because the quantity of games in any particular gaming session is player dependent, Walker '430 decreases the running count to reflect expiration of occurrences of the tracked symbols in the gaming session. This expiration of symbols helps Walker '430 to maintain the average expected payback percentage for that gaming session. If Walker '430 did not decrease the running count to reflect expiration of occurrences of the tracked symbols, a player could potentially extend the gaming session until the running count reached the predetermined level for a bonus payout, which would adversely affect the average expected payback percentage for that gaming session.

Further, Walker '430 discloses that "[i]t would be highly desirable to provide such a slot machine, where a player is motivated, on a consistent and ongoing basis, to prolong session play so as to avoid losing accumulated credits" (col. 3, lines 10 to 13) (emphasis added). That is, because the occurrences of the tracked symbols expire after a predetermined time (or a number of plays), the player is motivated to play, on a consistent and ongoing basis, the slot machine of Walker '430 so that any symbols accumulated in the gaming session count toward that player winning a prize. See Walker '430, col. 8, lines 50 to 63. Walker '430 causes accumulated symbols to expire such that players are encouraged to play "lengthier and faster play sessions," which in turn, increases the profit of the gaming device for an operator. See Walker '430, col. 1, lines 20 to 29 and col. 3, lines 24 to 32.

As described above, Walker '127 discloses a gaming device which provides a flat rate play session for a flat rate price. The flat rate play session of Walker '127 does not

appear to be ongoing like the gaming session of Walker '430. More specifically, Walker '127 discloses:

[t]he present invention is directed generally to a method and apparatus for operating a gaming device having a flat rate play session. As used herein, flat rate play session is defined as a period of play wherein the player need not make funds available for any play during the play session. The flat rate play session spans multiple plays of the gaming device. These multiple plays are aggregated into intervals or segments of play. It is to be understood that the term interval as used herein could be time, handle pulls, and any other segment in which slot machine play could be divided. For example, two hours, one hundred spins, fifty winning spins, etc. A player enters player identifying information and player selected price parameters at a gaming device. The price parameters define the flat rate play session, describing the duration of play, machine denomination, jackpots active, etc. The gaming device stores the player selected price parameters and proceeds to retrieve the flat rate price of playing the gaming device for the flat rate play session. The player selected price parameters, in combination with operator price parameters, determine the flat rate price. Should the player decide to pay the flat rate price, the player simply deposits that amount into the gaming device or makes a credit account available for the gaming device to debit. For example, it might cost twenty-five dollars to play for half an hour. Once the player initiates play, the gaming device tracks the flat rate play session and stops the play when the session is completed, usually when a time limit has expired. During the play session, the player is not required to deposit any coins. Payouts are made either directly to the player in the form of coins or indirectly in the form of credits to the credit balance stored in the machine. It should be understood that the player balance could be stored in a number of mediums, such as smart cards, credit card accounts, debit cards, and hotel credit accounts (col. 3, lines 20 to 53) (emphasis added).

With reference to FIG. 2b, the plan view of slot machine 102, will now be described below. FIG. 2b depicts slot machine 102 displaying player selected price parameter options on video display area 238. Included in the displayed parameters is amount wagered per play 712, interval 714, duration of interval 722, and active pay combinations 720. As will be described further below, after the player has

selected the desired price parameters, the slot machine 102 displays a flat rate price 724. Once the player has accepted the flat rate price and made the appropriate funds available, play may commence (col. 5, lines 36 to 46) (emphasis added).

* * *

During the flat rate play session, a slot machine 102 operates generally as described above with reference to FIG. 2. However, the slot machine 102 is reconfigured to operate according to the player selected price parameters, if such parameters affect play, and to operate continuously, without requiring payment between each play (col. 12, lines 38 to 44) (emphasis added).

Applicant respectfully submits that modifying the ongoing, player dependent gaming session of Walker '430 to be a flat rate play session like Walker '127 in the manner suggested by the Office Action would destroy the intended functionality of Walker '430. For example, if Walker '430 were modified to provide the player a flat rate play session having a designated time interval or a designated number of handle pulls as in Walker '127, the gaming device resulting from Walker '430 and Walker '127 would appear to end the player's flat rate play session after the designated time interval or the designated number of handle pulls. Thus, instead of causing the occurrences of the tracked symbols to expire as in Walker '430, the gaming device resulting from Walker '430 and Walker '127 would appear to designate an initial time interval or number of handle pulls and end the player's flat rate play session after the designated time interval or the designated number of handle pulls. As described above, the symbol expiration of Walker '430 encourages a player to play "lengthier and faster play sessions" and precludes the player from accumulating an unlimited number of symbols in accordance with the average expected payback percentage for that gaming session. Accordingly, the modification of Walker '430 and Walker '127 proposed by the Office Action would destroy the intended purpose of increasing operator profit by encouraging players to play "lengthier and faster play sessions," as disclosed in Walker '430.

Additionally, because Walker '430 requires a separate wager by the player for each play of a gaming session, Walker '430 teaches away from combination with the flat rate play session of Walker '127 which does not require payment between each play.

For at least the above reasons, it would not have been obvious to one of ordinary skill in the art at the time of the invention to combine Walker '430, Graham, and Walker '127 to result in the gaming device of Claim 1 without reasonably being construed as improper hindsight reconstruction. Only with the benefit of improper hindsight reasoning can the Examiner pick and choose different elements from Walker '430, Graham, and Walker '127 to recreate the claimed invention to form the basis of this rejection. Accordingly, Applicant submits that such reasoning is improper and thus this rejection is also improper.

Assuming, arguendo, that Walker '430, Graham, and Walker '127 are properly combinable in the manner suggested by the Office Action, the pending claims are still patentably distinguished over the combination of Walker '430, Graham, and Walker '127 and in condition for allowance.

As described above, the Office Action recognized that the combination of Walker '430 and Graham "lacks in explicitly teaching wherein the initial designated number of spins is greater than one and that the numerical quantity of spins is displayed. However, the Office Action relied on Walker '127 to remedy the proposed combination of Walker '430 and Graham. Specifically, page 5 of the Office Action states:

Walker '127 teaches that the "player enters player identifying information and player selected price parameters at a gaming device," which parameters include the "duration of play" (3:31-35). This teaching indicates that the number of handle pulls ("spins") is displayed to the player at least when he initiates the playing session.

Walker '127 appears to display the price parameter options and enable the player to select from the displayed options. More specifically, Walker '127 discloses "FIG. 2b depicts slot machine 102 displaying player selected price parameter options on video display area 238" and "[i]ncluded in the displayed parameters is amount wagered per play 712, interval 714, duration of interval 722, and active pay combinations 720." See Walker '127, col. 5, lines 37 to 41.

The price parameters (e.g., amount wagered per play 712, interval 714, duration of interval 722, and active pay combinations 720) of Walker '127 are parameters used by the gaming device of Walker '127 to structure the flat rate price for the flat rate

gaming session. After the player places the wager for the flat rate gaming session, Walker '127 does not appear to cause any of these parameters to indicate the quantity of initial spins remaining to be subsequently displayed in that flat rate gaming session.

Even if the interval 714 (e.g., handle pulls) and duration of interval 722 (e.g., one-hundred) of Walker '127 were interpreted to be "a first designated number" as in amended independent Claim 1, the interval 714 and duration of interval 722 do not appear to indicate a quantity of initial spins remaining. Additionally, neither the interval 714 nor the duration of interval 722 cause any indication of the quantity of initial spins remaining to be subsequently displayed in the flat rate gaming session.

Thus, unlike the gaming device of amended independent Claim 1, the gaming device resulting from the combination of Walker '430, Graham, and Walker '127 does not render obvious, among other elements, at least one memory device which stores a plurality of instructions, which when executed by the at least one processor, cause the at least one processor to: (i) display a first designated number, the first designated number being equal to a quantity of initial spins of the reels which will subsequently be displayed, the quantity of initial spins being greater than one, and (ii) after a wager by a player: (a) display one of the initial spins of the reels, (b) cause the first designated number to indicate the quantity of initial spins remaining to be subsequently displayed, and (c) repeat (a) and (b) until none of the quantity of initial spins remain.

Page 4 of the Office Action suggested that the player of Walker '430's game cannot accumulate 50 bar symbols in two spins because each spin results in only 9 symbols. Specifically, the Office Action states: "in the case where an initial designated number of spins equals two, each spin providing a maximum of nine symbols, the player is unable to win a minimum prize requiring 50 bar symbols."

Walker '430 enables the player to accumulate designated symbols in each spin, where each occurrence of the designated symbol(s) is counted or accumulated toward that player winning a prize (col. 8, lines 50 to 63). That is, Walker '430 enables the player to accumulate designated symbols in each spin and does not restrict its symbol accumulation for a prize to particular spins (i.e., a quantity of initial spins). Because Walker '430 does not restrict its symbol accumulation for a prize to particular spins,

Walker '430 controls the number of symbols accumulated by the player in the ongoing gaming session through symbol expiration as described above. Absent the use of impermissible hindsight, Walker '430 does not appear to cause a designated number of prize symbols necessary to be accumulated to win an associated physical prize to be greater than a number of prize symbols which can possibly be accumulated in the displayed initial spins of the reels.

Thus, unlike amended independent Claim 1, Walker '430 does not appear to render obvious, among other elements, at least one memory device which stores a plurality of instructions, which when executed by the at least one processor, cause the at least one processor to cause a physical prize to be awarded to the player if the accumulated number of prize symbols reaches a second designated number of prize symbols necessary to be accumulated to win the associated physical prize, wherein the second designated number of prize symbols is greater than the number of prize symbols which can possibly be accumulated in the displayed initial spins of the reels.

Neither Graham nor Walker '127 remedy Walker '430 in this regard. Assuming, arguendo, that Walker '430, Graham, and Walker '127 are properly combinable in the manner suggested by the Office Action, the combination of Walker '430, Graham, and Walker '127 does not appear to cause a designated number of prize symbols necessary to be accumulated to win an associated physical prize to be greater than a number of prize symbols which can possibly be accumulated in the displayed initial spins of the reels. Thus, unlike amended independent Claim 1, the gaming device resulting from the combination of Walker '430, Graham and Walker '127 does not appear to render obvious, among other elements, at least one memory device which stores a plurality of instructions, which when executed by the at least one processor, cause the at least one processor to cause a physical prize to be awarded to the player if the accumulated number of prize symbols reaches a second designated number of prize symbols necessary to be accumulated to win the associated physical prize, wherein the second designated number of prize symbols is greater than the number of prize symbols which can possibly be accumulated in the displayed initial spins of the reels.

For at least the above reasons, amended independent Claim 1 is patentably distinguished over the proposed combination of Walker '430, Graham and Walker '127 and is in condition for allowance.

Claims 2 to 27 depend directly from amended independent Claim 1 and are also allowable for the reasons given with respect to amended independent Claim 1 and because of the additional features recited in these claims.

Amended independent Claims 28, 40, 48, 56, 74, and 85 each includes certain elements similar to certain elements of amended independent Claim 1. For reasons similar to the reasoning discussed above with respect to amended independent Claim 1, amended independent Claims 28, 40, 48, 56, 74, and 85 (and their respective dependent Claims) are each patentably distinguished over the proposed combination of Walker '430, Graham and Walker '127 and are in condition for allowance.

Additionally, amended independent Claims 48 and 85 each include the following elements: "wherein the predetermined symbol combination including the re-trigger symbol must occur on the reels at least once to accumulate the second designated number of the first prize symbols," and "wherein the predetermined symbol combination including the re-trigger symbol must occur on the reels at least once to accumulate the second designated number of the first prize symbols."

Assuming, arguendo, that Walker '430, Graham, and Walker '127 are properly combinable in the manner suggested by the Office Action, the combination of Walker '430, Graham, and Walker '127 does not appear to restrict its symbol accumulation for a prize to particular spins (i.e., the initial spins provided to the player or the spins triggered by the occurrence of a re-trigger symbol). As discussed above, Walker '430 enables the player to accumulate designated symbols in each spin, where each occurrence of the designated symbol(s) is counted or accumulated toward that player winning a prize. Neither Graham nor Walker '127 remedy Walker '430 in this regard. Thus, unlike amended independent Claims 48 and 85, the gaming device or method resulting from the proposed combination of Walker '430, Graham and Walker '127 does not appear to render obvious a gaming device or a method which requires the predetermined symbol

combination including the re-trigger symbol to occur on the reels at least once to accumulate the second designated number of first prize symbols.

Accordingly, amended independent Claims 48 and 85 and their respective dependent claims are each patentably distinguished over the proposed combination of Walker '430, Graham and Walker '127 and are in condition for allowance.

Dependent Claims 24, 36, 37, 45, 52, 53, 69, 79, 80, 88 and 89 (which depend from one of amended independent Claims 1, 28, 40, 48, 56, 74 and 85) are each directed to a gaming device or method which requires, for a first wager made by the player, a first quantity of the prize symbols to be accumulated for the player to win the physical prize, and which requires, for a second, different wager made by the player, a second, different quantity of the first prize symbols to be accumulated for the player to win the physical prize.

Page 8 of the Office Action stated that "determining . . . [the] prize symbols necessary to win a prize . . . is based at least in part on a wager made by the player" and that "[e]ach of these determinations is described at least by the citations of Walker '430 herein because each determination must be established when the player initiates the wagering session." Applicant disagrees. Walker '430 does not appear to determine a quantity of prize symbols necessary to win a prize based on the player's wager. In Walker '430, though each game is initiated upon a wager made by the player and each game is associated with a number of prize symbols necessary to win a prize, the quantity of prize symbols necessary to win a prize is not determined based on different wagers made by the player. That is, Walker '430 does not appear to, for two different wagers made by the player, determine two different quantities of prize symbols necessary to be accumulated to win a physical prize.

Neither Graham nor Walker '127 remedies Walker '430 in this regard. Thus, unlike dependent Claims 24, 36, 37, 45, 52, 53, 69, 79, 80, 88 and 89, the proposed combination of Walker '430, Graham and Walker '127 does not render obvious a gaming device which comprises, for a first wager made by the player, a first quantity of the prize symbols to be accumulated for the player to win the physical prize, and which

requires, for a second, different wager made by the player, a second, different quantity of the prize symbols to be accumulated for the player to win the physical prize.

Accordingly, dependent Claims 24, 36, 37, 45, 52, 53, 69, 79, 80, 88 and 89 are each patentably distinguished over the proposed combination of Walker '430, Graham and Walker '127 and are in condition for allowance.


For at least the reasons set forth above, Claims 1-93 are patentable over the proposed combination of Walker '430, Graham and Walker '127 and are in condition for allowance.

An earnest endeavor has been made to place this application in condition for allowance and is courteously solicited. If the Examiner has any questions related to this Response, Applicant respectfully requests that the Examiner contact the undersigned.

Respectfully submitted,

K&L Gates LLP

BY


Adam H. Masia
Reg. No. 35,602
Customer No. 29159
(312) 807-4284

Dated: February 12, 2010